



09 JAN 2007

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In re Application of
Verra et al.
Application No. 10/560,146
PCT No.: PCT/FR04/01446
Int. Filing Date: 10 June 2004
Priority Date: 12 June 2003
Atty. Docket No.: 377/9-2182
For: Bone Marrow Aspiration Trocar

COMMUNICATION

This is in response to the "Petition Under 37 CFR 1.47(b)..." filed on 06 October 2006 and the "Petition To Withdraw Petition" filed on 14 November 2006.

DISCUSSION

In a Communication mailed on 03 April 2006, it was noted that

Review of the declaration of the inventors filed on 09 December 2005 reveals that it names two inventors, Hacene ZERAZHI and Borhane SLAMA, who are also named in the published international application. Further inspection of the published international application reveals that it refers to another inventor (Yvan Verre), not nominated by the declaration, as "l'inventeur décédé." Counsel is required to remedy this discrepancy. In the event that Mr. Verre was not properly named as an inventor, counsel may wish to proceed under 37 CFR 1.497(d). Alternatively, 37 CFR 1.42 provides in part that

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

In the event that counsel elects to proceed under 37 CFR 1.42, care should be taken to ensure that the declaration provides citizenship, residence and postal address information for both the legal representative(s) and for the deceased inventor.

In response, petitioner has filed the two instant petitions. Both petitions will be considered together in addressing the issues arising under 37 CFR 1.47 and 1.42, respectively.

Petition Under 37 CFR 1.47(a)

As a preliminary matter, the petition filed on 06 October 2006 properly should have been brought under 37 CFR 1.47(a), since at least one of the joint inventors executed the declaration. Therefore, the 06 October 2006 petition will be treated as a petition under 37 CFR 1.47(a).

The petition filed on 14 November 2006 in essence states that the petition filed on 06 October 2006 is moot because “counsel continued to attempt to contact the heirs of the deceased co-inventor, Yvan Verra, and contact was established... a copy of the fully executed declaration is enclosed herewith.” Inspection of the declaration filed on 14 November 2006 reveals that has been executed by inventors Borhane Slama and Hacene Zerazhi, as well as by three “heirs” of the deceased inventor.” As such, the petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

Submission Under 37 CFR 1.42

Review of the record, including the declaration filed on 14 November 2006, reveals that joint inventor Yvan Verra is indicated to be “deceased.” 37 CFR 1.42 provides in part that

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Further examination of the declaration filed on 14 November 2006 reveals that Ollivier Verra, Florence Verra and Raphael Verra have signed in the capacity of “first,” “second,” and “third of three of the deceased inventor’s sole heirs,” respectively. This language does not unambiguously indicate that those three heirs are in fact all of the “sole heirs;” rather, the concept of “three of the deceased inventor’s sole heirs” admits the possibility that the class of “the deceased inventor’s sole heirs” includes more than three members, and that only a subset of “three of” those members have signed. In the absence of a statement that the three heirs who executed the declaration on behalf of Yvan Verra in fact are “all” of the heirs of Yvan Verra, it would not be appropriate to accept the declaration under 37 CFR 1.42 at this time.

It is noted that the declaration provides “the facts which the inventor would have been required to state” in that Yvan Verra’s citizenship, residence and mailing address information is

provided. Moreover, the declaration also includes the citizenship, residence and mailing address data for each of the heirs signing on behalf of Yvan Verra.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

The declaration is **NOT ACCEPTED** under 37 CFR 1.42, without prejudice

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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